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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,146	11/28/2000	Mike Binnard	PA0324-US\11269.21	6125

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EXAMINER

STOCK JR, GORDON J

ART UNIT PAPER NUMBER

2877

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,146

Applicant(s)

BINNARD ET AL.

Examiner

Gordon J Stock

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13, 16-30 and 33-44 is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 14, 15, 31 and 32 is/are rejected.
- 7) ☒ Claim(s) 6-8 and 10-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 6) ☐ Other: _____

DETAILED ACTION

1. The preliminary amendment filed on 28 January 2003 necessitated this new action.

Claim Objections

2. **Claim 32** is objected to for the following: the method steps of claim 32 do not appear to describe a method of making a device (specifically, all the providing steps and the step of exposing a pattern onto the device). Therefore, a new preamble to the method is required that is clearly indicative of the method to which the steps are directed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 31 and 32** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. **Claim 31** provides for the use of the exposure apparatus made by method of claim 30, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 31 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex*

Art Unit: 2877

parte Dunki, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

6. **Claim 32** is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the actual steps of making the device that comprise the step of “assembling the device on which the pattern has been formed.”

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 14 and 15** are rejected under 35 U.S.C. 102(e) as being anticipated by **Osanai et al. (6,285,444)** (cited by Examiner in previous action)

As for **claims 14-15**, Osanai in a positioning system and position measuring method for use in an exposure apparatus discloses the following: a device, a wafer (col. 9, lines 33-60). As for the statements “manufactured with the exposure apparatus according to claim 1” and “on which an image has been formed by the exposure apparatus of claim 13” “even though product-by-process claims are limited by and defined by a process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a

Art Unit: 2877

product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F. 2d 695,698, 227 USPQ 964,966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-5, and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Osanai et al. (6,285,444)** in view of **Nishi (4,897,553)** (both cited by examiner in previous action).

As for **claims 1 and 9**, Osanai in a positioning system discloses the following: a device table that retains the device; a stage mover assembly connected to the device table, the stage mover assembly moves the device table; a measurement system for monitoring the position of the device table, the measurement system including a first X mirror and a second X mirror (auxiliary mirror) that are secured to the device table (Fig. 1, Fig. 7; col. 7, lines 30-45; col. 11, lines 20-67; col. 12, lines 1-45).

Osanai is silent concerning fiducial marks. Nishi in an exposure apparatus discloses three fiducial marks on a stage for horizontal alignment (col. 3, lines 20-45; col. 4, lines 15-20). Therefore, it would be obvious to one skilled in the art at the time the invention was made to have a first, second, and third fiducial mark secured to the stage for an exposure apparatus in order to perform horizontal alignment.

Art Unit: 2877

As for **claim 2**, Osanai in view of Nishi discloses everything as above (see **claim 1**). In addition, Osanai discloses the measurement system includes a first X block that interacts with the first X mirror to monitor the position of the device table (Fig. 7, **33a-33c**; col. 11, lines 40-45).

As for **claim 3**, Osanai in view of Nishi discloses everything as above (see **claim 2**). In addition, Osanai discloses the first x block interacts with the first x mirror to monitor the position of the stage when the table is in alignment position (Fig. 8, col. 11, lines 25-67; col. 12, lines 1-67; col. 13, lines 1-35).

As for **claims 4-5**, Osanai in view of Nishi discloses everything as above (see **claim 3**). In addition, Osanai discloses the second x block interacts with the second x mirror to monitor the position of the stage when the table is in operational position (Fig. 7, **41**; Fig. 8, col. 11, lines 25-67; col. 12, lines 1-67; col. 13, lines 1-35).

Allowable Subject Matter

11. **Claims 6-8 and 10-12** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 31-32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

As to **claim 6**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a stage assembly a control system that utilizes the first fiducial mark and the second fiducial mark to determine the position of the first X mirror relative to the second X mirror, in combination with the rest of the limitations of **claims 6-8**.

Art Unit: 2877

As to **claim 10**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a stage assembly a control system that utilizes the first fiducial mark, the second fiducial mark, and the third fiducial mark to determine the position of the first X mirror relative to the second X mirror, in combination with the rest of the limitations of **claims 10-12**.

As to **claim 32**, the prior art of record taken alone or in combination, fails to disclose in method pertaining to a device “providing a first movable stage that moves in a first direction and a second direction different from the first direction, the first movable stage holding the device and having a first reflective portion extending in the first direction, a second reflective portion parallel to the first reflective portion, and a first mark portion having a plurality of fiducial marks;” “providing a first mark detector that detects the plurality of fiducial marks when the first position detector detects the position of the first movable stage;” “providing a second mark detector that detects the plurality of fiducial marks when the second position detector detects the position of the first movable stage; providing a controller that communicates with the first position detector, the second position detector, the first mark detector, and the second mark detector to correlate the first reflective portion with the second reflective portion,” in combination with the rest of the limitations of **claim 32**.

12. **Claims 13, 16-30, 33-44** are allowed.

As to **claim 13**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in an exposure apparatus “a first movable stage that moves in a first direction and a second direction different from the first direction, the first movable stage holding a first substrate and having a first reflective portion extending in the first direction, a second reflective portion parallel to the first reflective portion, and a first mark portion having a plurality of

Art Unit: 2877

fiducial marks,” “a first mark detector that detects the plurality of fiducial marks when the first position detector detects the position of the first movable stage,” “a second mark detector that detects the plurality of fiducial marks when the second position detector detects the position of the first movable stage,” and “a controller that communicates with the first position detector, the second position detector, the first mark detector, and the second mark detector to correlate the first reflective portion with the second reflective portion,” in combination with the rest of the limitations of **claims 13, 33-44**.

As to **claim 16**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method for determining the relative positions of a first X mirror and a second mirror that are secured to a device table the step of determining the position of the first X mirror relative to the second X mirror using the first fiducial mark and the second fiducial mark, in combination with the rest of the limitations of **claims 16-23**.

As to **claim 24**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method pertaining to a stage assembly that moves device the step of determining the position of the first X mirror relative to the second X mirror using the first fiducial mark and the second fiducial mark, in combination with the rest of the limitations of **claims 24-31**.

Fax/Telephone Numbers

If the applicant wishes to send a fax dealing with either a proposed amendment or a discussion with a phone interview, then the fax should:

1) Contain either a statement “DRAFT” or “PROPOSED AMENDMENT” on the fax cover sheet; and

Art Unit: 2877

2) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

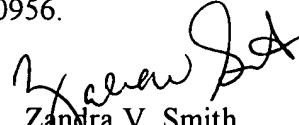
Papers related to the application may be submitted to Group 2800 by Fax transmission. Papers should be faxed to Group 2800 via the PTO Fax machine located in Crystal Plaza 4. The form of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine number is: (703) 308-7722

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon J. Stock whose telephone number is (703) 305-4787. The examiner can normally be reached on Monday-Friday, 10:00 a.m. - 6:30 p.m.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

gs

July 13, 2003


Zandra V. Smith
Primary Examiner
Art Unit 2877